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REMARKS

New Claim 85 is based on the disclosure at page 17, lines 1-15; new Claim 86 is based on previous Claim 5; new Claim 87 is based on page 15, last paragraph, and page 17, first paragraph; new Claim 88 is based on page 25, lines 3-6. Thus, Claims 1-11, 3-22, and 25-88 are pending; Claims 1-11, 14, 25, 27, 37 and 83-88 are under consideration; and Claims 13, 15-22, 28-36 and 38-82 are withdrawn from consideration.

The Office Action has rejected Claims 1-11, 14, 25, 27, 37, and 83-84 for the following reasons:

(i) Claim 1 and 8 are rejected under 35 U.S.C. §112 for failing to comply with the written description requirement, in that “a spacer disposed around said return electrode” as set forth in Claim 1, and “the return electrode coil is wound in a proximal direction away from said shaft distal end” as set forth in Claim 8 are not supported in the Application as filed;

(ii) Claim 5 is rejected under 35 U.S.C. §112, second paragraph for being indefinite because a broad range and a narrow range are recited in the same claim, and thus the scope of the claim cannot be determined;

(iii) Claims 1-3, 6, 8, 27, 83-84 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent no. 5,047,027 to Rydell (“Rydell”) for the reasons indicated in the Office Action;

Claims 4-5, 9-11, 14, 25 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable under Rydell in view of U.S. Patent no. 5,891,134 to Goble (“Goble”), and/or U.S. Patent no. 6, 280,441 to Ryan (“Ryan”) for the reasons indicated in the Office Action;

(iv) Claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Rydell in view of U.S. Patent no. 4,832,048 to Cohen (“Cohen”) for the reasons indicated in the Office Action.

(v) Claim 7 is objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form to include all limitations of the base claims and intervening claims.

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The drawing is objected to under 37 CFR 1.83(a) for the same reason that Claims 1 and 8 are rejected under 35 U.S.C. §112, as noted above.

In view of the present amendments, reconsideration and allowance of the Application is respectfully requested.

Re. The rejection of Claim 1 under 35 U.S.C. §112 and the 37 CFR 1.83(a) Objection to the Drawing

Claim 1 is amended to specify that the spacer is disposed around the active electrode as illustrated, for example, in Fig. 16B. Hence withdrawal of the rejection of Claim 1, and the objection to the Drawing is respectfully requested.

Re. The rejection of Claim 8 under 35 U.S.C. §112 and the 37 CFR 1.83(a) Objection to the Drawing

Claim 8 is amended to specify that the coil is wound in a proximal direction towards the shaft distal end as indicated, for example, in Fig. 16B. Hence withdrawal of this rejection of Claim 8, and the objection to the Drawing is respectfully requested.

Re. The rejection of Claim 5 under 35 U.S.C. §112, second paragraph

Claim 5 is amended to delete the range of about 0.012 to about 0.025 inches. Hence withdrawal of the rejection of Claim 5 is respectfully requested.

Re. The rejection of Claims 1-3, 6, 8, 27, 83-84 under 35 U.S.C. §102(b) as anticipated by Rydell

Claim 1 is amended to specify an electrically conductive fluid delivery element adapted to deliver an electrically conductive fluid in the vicinity of said active electrode, which is not disclosed in Rydell. Support for the conductive fluid supply can be found for example at page 7, last paragraph of the specification, and a fluid delivery element is indicated, for example, on Fig. 17B, reference no. 1162c. Accordingly, withdrawal of this rejection of Claim 1 and dependent Claims 2-3, 6, 8, 27, 83-84 is respectfully requested.

Re. The rejection of Claims 4-5, 9-11, 14, 25 and 27 under 35 U.S.C. § 103(a) as being unpatentable under Rydell in view of Goble and/or Ryan

In view of the amendment to Claim 1 to specify an electrically conductive fluid delivery element adapted to deliver an electrically conductive fluid in the vicinity of said

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active electrode, as discussed above and which is not suggested by Rydell in view of Goble and/or Ryan, withdrawal of this rejection of Claim 1 is respectfully requested.

Re. The rejection of Claims Claim 37 under 35 U.S.C. § 103(a) as being unpatentable over Rydell in view of Cohen

In view of the amendment to Claim 1 to specify an electrically conductive fluid delivery an electrically conductive fluid in the vicinity of said active electrode, as discussed above and which is not suggested by Rydell in view of Cohen, withdrawal of this rejection of Claim 1 is respectfully requested.


Re. The objection and allowability of Claim 7

The Applicants acknowledge with thanks the allowability of Claim 7, however in view of the amendment Claim 1 upon which Claim 7 depends, Claim 7 is not rewritten.

SUMMARY

The claims as amended are patentable and the Application is in condition for allowance. Accordingly, reconsideration and allowance of the Application is respectfully requested. If any issue remains and a telephone conference would expedite prosecution of the Application, kindly telephone the undersigned at (408) 735-6486.

Respectfully submitted,


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